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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,876	01/29/2002	Taiji Sasage	1614.1211	2384
21171	7590	05/09/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PICH, PONNOREAY	
			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,876

Applicant(s)

SASAGE ET AL.

Examiner

Ponnoreay Pich

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the-certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claims 1-8 are pending. Claims 7-8 were newly added by applicant. Any objections or rejections from the prior office action not repeated below for record are withdrawn due to applicant's amendments and/or arguments. Any well known art statements made in the prior office action not specifically traversed by applicant are taken as admittance of prior art as per MPEP 2144.03C.

Response to Amendments and Arguments

Applicant's arguments have been fully considered, but are moot in view of new grounds of rejections presented below in response to applicant's amendments, which changes the scope of the claims.

The examiner notes that the prior office action rejected claims 4-6 under 35 USC 112, second paragraph as containing similar errors as claims 1-3. The examiner notes that applicant's amendments have fixed the previously noted 112, second paragraph errors for claims 1-3, but applicant did not fix several errors that were also present in claims 4-6. See further explanation below.

The examiner further notes that the manner that applicant amended claim 1 does not comply with 37 CFR 1.121. Line 11 of the claim has several words which were marked using underlining and strikethrough, thus it appears applicant added the words to the claim and then immediately marked them for deletion. Applicant may have done this by accident and this might explain why the meaning of step c in claim 1 is indefinite even after applicant's amendments.

The examiner also notes that applicant requested authority for the statement in the prior office action of virus emails and spam emails being known in the art. In response, the examiner respectfully directs applicant to Gibbs (US 6,615,348), wherein he discloses spam emails being known in the art at the time applicant's invention was made and spam email containing viruses, i.e. virus emails, was known in the art at the time applicant's invention was made (col 1, lines 10-16).

Claim Objections

Claim 1 is objected to because of the following informalities: In line 8, there should be an "a" after "into". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Step c of claim 1 has been amended to recite "suppressing sending other electronic mail the electronic mail including the mail virus information". The meaning of this step is indefinite—it appears to be a fragmented phrase.
2. Claim 2 further defines the method of claim 1 as further comprising a step c. However, claim 1 already contains a step c. The examiner assumes applicant

either meant step d in claim 2 or applicant meant to further define step c of claim 1.

3. As per claim 2, it is recited that virus detection is reported. Applicant's specification seems to indicate that such reporting is done via email. However, step c recited in claim 1 has stated that other electronic mail has been suppressed from sending. It is unclear how the reporting in claim 2 can be accomplished if email has been suppressed. Claim 5 contains a similar problem.
4. Claim 3 further defines a step c for claim 1. However, claim 1 already has a step c.
5. Claim 3 recites "sending the report electronic mail attaching the electronic mail compressed in step (d)". This phrase is indefinite. The examiner assumes applicant meant something along the lines of sending the report electronic mail and attaching the electronic mail compressed in step (d) to the report electronic mail?
6. As per claim 3, it is unclear how sending of the report electronic mail can be accomplished since claim 1 has been amended to recite that other electronic mail is suppressed. The report electronic mail is "other electronic mail". Claim 6 contains a similar problem.
7. As per claim 4, step b refers to step a determining that the electronic mail indicates the second address for the mail virus detection. Step a recites that it is determined whether or not a first address indicated by the electronic mail transmitted through the network is the same as a second address.... It is unclear

if the indication referred to in step b is the first address being the same as a second address. For purposes of applying art, the examiner assumes that to be the case.

8. Claim 5 recites "electronic mail detected in said code (a)". There does not appear to be any electronic mail that was detected in code (a) of claim 4.
9. Claim 7 refers to comparing a "first type" with a "second type". It is unclear even after reading applicant's specification what is "a first type" and "a second type". Perhaps applicant meant something along the lines of comparing the first piece of electronic mail and the second piece of electronic mail to see if they're the same type and if they are, suppressing transmission of the second piece of electronic email?
10. As per claim 7, "substantially equivalent" is recited in line 6. The examiner submits that the metes and bounds of claim 7 cannot be determined because one skilled would not know how equivalent the second type has to be to the first type for it to be "substantially equivalent". Applicant's specification does not define what is encompassed by the relative term "substantially".
11. The limitation as recited in claim 8 is indefinite. The examiner assumes there should be an "or" before "a title". Further, the examiner suspects there should be a comma before "which".
12. Any claims not specifically addressed are rejected by virtue of dependency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 8, 4, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (US 6,052,709) in view of Gibbs (US 6,615,348).

Claim 1:

Paul discloses:

1. (a) determining whether or not a first address indicated by the electronic mail transmitted through a network indicates/is the same as a second address recorded in an address table for spam detection to receive spam messages, instead of receiving a regular electronic mail (col 2, lines 50-56 and col 4, lines 18-34 and 47-56).
2. (b) storing information concerning the electronic mail as spam information into a spam information table when the first address of the electronic mail indicates the second address (col 54, lines 53-56; col 5, lines 1-20; and col 5, line 55-col 6, lines 16).
3. (c) suppressing sending other electronic mail the electronic mail including the spam information (col 6, line 64-col 7, line 1).

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Paul does not explicitly disclose spam messages being mail virus messages and spam information being mail virus information. However, Gibbs discloses spam messages usually containing viruses (col 1, lines 10-16). One skilled should appreciate that in such instances, spam messages and virus messages are one in the same.

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to utilize Paul's teachings in an email virus detection system such that any spam message detected is assumed to contain a virus. One skilled would have been motivated to do so because as Gibbs discloses, spam messages often contain viruses (col 1, lines 10-16). Utilizing Paul's teachings to prevent a possibly infected spam message from being delivered to a user would cause the user's network to be more secure and prevent a user from accidentally activating a virus that was attached to a spam message.

Claim 8:

As per claim 8, Paul further discloses the spam information indicates at least one of values of a sender's electronic mail address, a data size, a title which are shown in the electronic mail indicating the second address (col 5, lines 1-20 and col 5, line 53-col 6, line 16). Paul does not disclose spam information being mail virus information.

However, as discussed in claim 1, spam messages and virus messages were often the same thing at the time applicant's invention was made. It would have been obvious to one of ordinary skill in the art to have spam information be mail virus information for the same reasons and motivation given in claim 1.

Claim 4:

The rejection of claim 1 addresses all the limitations found in claim 1. The rejection of claim 1 applies to claim 4.

Claim 7:

Paul discloses:

1. Comparing a first type of a first piece of electronic mail to a second type of a second piece of electronic mail (col 8, lines 14-43).
2. Suppressing a transmission of said second piece of electronic mail if said second type is substantially equivalent to said first type and an address of said first piece of electronic mail is an address for spam detection (col 8, lines 14-43 and col 9, lines 48-52).

Paul does not disclose spam detection being mail virus detection. However, Gibbs discloses spam messages usually containing viruses (col 1, lines 10-16). One skilled should appreciate that in such instances, spam messages and virus messages are one in the same.

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to utilize Paul's teachings in an email virus detection system such that any spam message detected is assumed to contain a virus, i.e. mail virus detection. One of ordinary skill would have been motivated to utilize Paul's teachings in an email virus detection system for the same reasons given in claim 1.

Claims 2-3 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (US 6,052,709) in view of Gibbs (US 6,615,348) and further in view of Smithson et al (US 6,898,715).

Claim 2:

Paul does not disclose a step of (c) reporting a mail virus detection based on the determination in said step (a) to at least one predetermined report address. However, Smithson discloses reporting a mail virus detection based on determining that an email may contain a virus to at least one predetermined report address (col 3, lines 58-64 and col 6, lines 27-36).

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to further modify the invention as recited in claim 1 according to the limitations recited in claim 2 in light of Smithson's teachings. One skilled would have been motivated to incorporate Smithson's teachings because it would allow an administrator to perform an analysis of the email and take further action. Note Paul expresses an interest in having an administrator be able to further analyze emails that have been identified by his invention (col 5, lines 5-9).

Claim 3:

Paul does not disclose the steps of:

1. (d) compressing the electronic mail detected in said step (a).
2. (e) attaching the electronic mail compressing in said step (d) to a report electronic mail for reporting the mail virus detection, wherein a step (c) reports

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the mail virus detection by sending the report electronic mail the electronic mail compressed in said step (d).

However, compressing electronic messages/mails before sending it was well known in the art at the time applicant's invention was made. It would have been obvious to one of ordinary skill in the art to first compress electronic mail before sending it because it would allow the mail to be sent faster and the mail to take up less storage space in the receiver's hard drive.

Further, Smithson discloses automatically sending computer files suspected of being infected with a computer virus to a repository so that they may be analyzed, i.e. attaching electronic mail that was detected to a report mail for reporting mail virus detection (col 3, lines 58-64 and col 6, lines 27-36).

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to compress the electronic mail and attach the electronic mail to a report electronic mail for reporting mail virus detection. One skilled would have been motivated to incorporate Smithson's teachings and report the electronic mail for the same reasons given in claim 2.

Claim 5:

The limitations recited in claim 5 are substantially similar to what is recited in claim 2 and claim 5 is rejected for the same reasons given in claim 2. The difference is that in claim 2, reporting is based on the determination of addresses in step (a), while in claim 5, the reporting is based on the electronic mail detected in said code (a). One

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skilled should appreciate that the addresses could not have been determined unless the electronic mail was detected.

Claim 6:

Claim 6 recites limitations substantially similar to what is recited in claim 3 and is rejected for the same reasons.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PP

Ponnoreay Pich
Examiner
Art Unit 2135



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